

MANFRED T. REETZ ET AL.
USSN 09/463,494
REPLY TO OFFICE ACTION DATED AUGUST 18, 2004
AMENDMENT OF JULY 18, 2005

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

The sole issue for consideration is the rejection of claims 42-47 under 35 U.S.C. §103(a) as being obvious over either of Nakanishi, et al. (N), Hirose, et al. (U-2) or Krainev, et al. (V-2) in view of Williams, et al. (A), Zhou, et al. (U), Leung, et al. (V), Cadwell, et al. (W), and Shinkai, et al. (X). In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

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Applicants do not believe the references are fairly combined to achieve the present invention. An aspect of the present invention is the development of the first high-throughput spectrophotometric assays, which is of great practical importance.

In particular, at the bottom of page 3 of the specification, there is the teaching that:

"[T]he production of mutants with improved stereoselectivity by the methods of *in vitro* evolution has not been successful to date, because an efficient screening method for enantioselectivity testing still does not exist."

Then, in the first full paragraph on page 5 of the specification there is the teaching that:

"[N]aturally occurring hydrolase genes can be mutagenized by a modified polymerase chain reaction (PCR), changing certain reaction parameters, to obtain an extensive mutant library which can be *screened for mutants having improved enantioselectivity using a novel test method.*"

Then, in the third paragraph on page 11, there is the teaching that in one preferred embodiment:

"[T]he activity of the lipase or esterase is determined by *spectrophotometry.*"

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The instant claims have now been directed to this embodiment of the present invention by the insertion of new step d) in claim 42 and new step e) in claim 45 and other editorial changes. In view of the foregoing explanation, Applicants do not believe the amendments introduce new matter.

There is no teaching or suggestion in the cited combination of references that would have led persons skilled in the art to this embodiment of the present invention. Therefore, Applicants submit that the cited combination of references fails to make out a *prima facie* case of the obviousness of the present claims.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to

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telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS MC LAUGHLIN & MARCUS, P.A.

By

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 and the accompanying Request for Continued Examination and Petition for Extension of Time (12 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: July 18, 2005

By:

Kurt G. Briscoe